

**REMARKS**

This Application has been carefully reviewed in light of the Office Action mailed October 1, 2004 ("Office Action"). Claims 1-25 are pending in the present application and currently stand rejected.

**I. Section 112 Rejections**

The Examiner rejected Claims 4-5, 8-11, 13, 15-16, 19-22, and 24-25 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

**1. Claims 5, 8, 9, 10, 11 16, 19, 20, 21, 22, and 25**

The Examiner rejected Claims 5, 8, 10, 11, 16, 19, 21, and 22 for lack of antecedent basis and Claim 25 for use of the term "system" in the preamble of a method claim. The Examiner additionally rejected Claims 9 and 20 as being "vague and indefinite" for utilizing the term "reasonable". Appropriate amendments have been made. Accordingly, Applicant requests removal of these rejections.

**2. Claims 4, 13, 15, and 24**

The Examiner rejected Claims 4, 13, 15, and 24 as being "vague and indefinite" for utilizing the term "and combinations thereof". Applicant respectfully traverses this rejection. The test for indefiniteness as the Examiner is aware is whether "those skilled in the art would understand what is claimed when the claim is read in light of the specification." M.P.E.P. §2173.02. These phrase simply means that one could display or store a combination of the other members of the Markush group. (A search of the USPTO's online database (<http://patft.uspto.gov/netahtml/search-bool.html>) of claims of patents that have been granted since 1976 would reveal that some 35,000+ of these patents utilize the term "and combinations thereof" in their claims.) Thus, Applicant submits that the term "and combination thereof" would be understood by those skilled in the art. Accordingly, Applicant requests removal of these rejections.

## **II. Section 101 Rejections**

The Examiner rejected Claims 14-25 under 35 U.S.C. § 101 as being directed towards non-statutory subject matter. While Independent Claim 14 has been amended without prejudice, Applicant nevertheless disagrees with the rejection. The standard, as articulated in *State Street Bank and Trust Co. v. Signature Financial Group, Inc.*, 149 F.3d 1368, 45 U.S.P.Q.2d 1596 (Fed. Cir. 1998), provides that claimed subject matter is statutory if it produces a useful, concrete and tangible result. *State Street*, 149 F.3d at 1373, citing *In re Alappat.*, 31 U.S.P.Q.2d 1545, 1558 (Fed. Cir. 1994). With regards to this rejection, the Applicant notes that the Examiner indicated that the such a threshold requirement was met, indicating “the claimed invention determines and displays schedule recovery date information, thereby producing a useful, concrete, and tangible result.” Office Action, Page 4. Accordingly, the § 101 rejection should not have been made.

## **III. Section 103 Rejections**

The Examiner rejected Claims 1-8, 12-19, and 23-25 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,907,490 issued to Oliver (“*Oliver*”), in view of U.S. Patent Publication No. 2002/0052770, listing Podrazhansky as an inventor (“*Podrazhansky*”). The Examiner additionally rejected Claims 9-11 and 20-22 under 35 U.S.C. § 103(a) as being unpatentable over *Oliver*, in view of *Podrazhansky*, in further view of U.S. Patent Application No. 6,574,605 B1 issued to Sanders et al. (“*Sanders*”). Applicant respectfully traverses these rejections for the reasons stated below.

### **1. Lack of Establishment of Proper Support in a Priority Document for the Subject Matter Utilized in Rejection**

As an initial matter, Applicant notes that *Podrazhansky*, a reference utilized for every §103 rejection in the Office Action, has an actual filing date after the filing date of the current Application. Therefore, *Podrazhansky* cannot be used to reject the claims under 102(e) or 102(e)/103 unless there is “proper support for the subject matter as required by 35 U.S.C. 119(e) or 120” in a priority document with a filing date earlier than the present Application (and subject to any possible swear behind). See M.P.E.P. §706.02,

Example 2 and M.P.E.P. §2136.03. In the present case, *Podrazhansky* claims priority to a provisional application. However, this provisional application was not referenced in the Office Action. Additionally the Office Action gave no indication of what elements in the provisional application were intended to provide "proper support for the subject matter" in *Podrazhansky* utilized in rejecting the claims. Therefore, Applicant submits that should a rejection of the current Application be maintained, utilizing *Podrazhansky*, the Examiner must (1) establish the rejection based on the disclosure of *Podrazhansky*, and (2) include a showing of support of that disclosure in the provisional application to which *Podrazhansky* claims priority. Additionally, should this rejection be maintained upon the above establishment, Applicant reserves the right to swear behind the provisional application to which *Podrazhansky* claims priority.

Applicant believes this will be unnecessary, however, as the obviousness rejection can be overcome.

**2. The Proposed Oliver- Podrazhansky Combination Fails to Disclose, Teach, or Suggest Various Limitations Recited in Claim 1**

As the examiner is aware, a *prima facie* case of obviousness requires a teaching or suggestion of all the claim limitations. The combination of the *Oliver* and *Podrazhansky* references as suggested by the Examiner fails to disclose at least the following limitation of Claim 1:

“determine schedule recovery date (SRD) information from the project task data and earned value information”

The Examiner acknowledges in the current Office Action that *Oliver* does not disclose, teach, or suggest “schedule recovery date (SRD) information.” Office Action, Page 5 (“*Oliver* does not explicitly disclose determining schedule recovery date (SRD) information”). Instead, the Examiner relies on *Podrazhansky* for disclosure of this feature, citing paragraph 54 of *Podrazhansky*. Specifically, the Examiner indicates that paragraph 54 of *Podrazhansky* “discloses displaying the aggregate cost of the schedule for a time period, selectable by the user” and “discloses the aggregate cost based upon historical labor cost”. Office Action, Page 5 (emphasis added). Applicant respectfully submits that

disclosure of “aggregate cost” is not disclosure of “schedule recovery date (SRD) information.” The passage relied upon by the Examiner does not disclose providing date information, let alone schedule recovery date information.

Thus, Applicant submits that the combination of *Oliver* and *Podrazhansky* as suggested by the Examiner, fails to teach or suggest all the claim limitations. For at least this reason, Claim 1 and its dependent claims are allowable. For similar reasons, Claim 14 and its dependent claims are allowable.

### **3. The Proposed *Oliver-Podrazhansky* Combination is Improper**

As the examiner is aware, a *prima facie* case of obviousness additionally requires a motivation to combine the references. Even assuming for the sake of argument that *Oliver* and *Podrazhansky* disclosed each and every element of the invention defined by Claims 1, there is no motivation to combine them. The Examiner’s motivation to combine *Oliver* and *Podrazhansky* was indicated in the Office Action as follows:

“Both *Oliver* and *Podrazhansky* are concerned with effective scheduling management, therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include SRD information in *Oliver*, as seen in *Podrazhansky*, in order to efficiently determine current scheduling costs, thereby allowing management to make more effective decisions.” (Office Action, Page 5).

The fact that both references relate to project management does not provide a motivation to combine. The alleged motivation stemming from more efficient project management is simply hindsight reconstruction. Nothing in either *Oliver* or *Podrazhansky* suggests that the disclosure therein standing alone has efficiency problems. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.

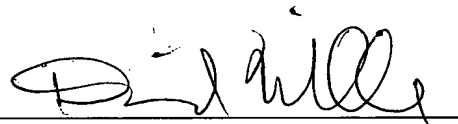
**CONCLUSION**

Applicant has made an earnest attempt to place this case in condition for immediate allowance. For the foregoing reasons and for other reasons clear and apparent, Applicant respectfully requests reconsideration and allowance of the pending claims.

Applicant does not believe any fees are due. However, the Commissioner is hereby authorized to charge any additional fees or credit any overpayment to Deposit Account No. 05-0765 of Electronic Data Systems Corporation.

If there are matters that can be discussed by telephone to advance prosecution of this application, Applicant invites the Examiner to contact its attorney at the number provided below.

Respectfully submitted,  
Baker Botts L.L.P.  
Attorneys for Applicant



David G. Wille  
Reg. No. 38,363  
(214) 953-6595

Dated: January 3, 2005

**CORRESPONDENCE ADDRESS:**

**at Customer No. 35005**